No. 87-1241

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1987

COMMONWEALTH OF PENNSYLVANIA,
Petitioner,

– v. –

UNION GAS COMPANY,
Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

BRIEF OF NATIONAL MUSIC PUBLISHERS' ASSOCIATION, INC.; AMERICAN SOCIETY OF COMPOSERS, AUTHORS AND PUBLISHERS; BROADCAST MUSIC, INC.; MUSIC PUBLISHERS' ASSOCIATION OF THE UNITED STATES; AND THE SONGWRITERS GUILD OF AMERICA AS *AMICI CURIAE* IN SUPPORT OF RESPONDENT

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TABLE OF CONTENTS

TABLE OF AUTHORITIES

Constitutional and Statutory Provisions

Other Authorities

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This *amicus curiae* brief is submitted in support of the position of respondent Union Gas Company on the third question presented, concerning Congress' power to abrogate Eleventh Amendment immunity under Article I of the Constitution. By letters filed with the Clerk of the Court, petitioner and respondent have consented to the filing of this brief.

Interest Of *Amici Curiae*

These *amici* are organizations representing the interests of thousands of music copyright owners and the entities which publish their music and collect the copyright royalties which are their principal source of income. The value and enforceability of copyrights are, quite simply, the lifeblood of the music industry.

These *amici* have a direct interest in the outcome of this case because that lifeblood flows from an act of Congress, the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*, enacted under Article I of the Constitution. The Copyright and Patent Clause of that Article gave Congress the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . ." U.S. Const., Art. I, § 8, Cl. 8.

In *Goldstein* v. *California*, 412 U.S. 546 (1973), this Court reiterated the doctrine that the Copyright and Patent Clause established Congress' *exclusive* power to provide for a *uniform* national system of copyright and patent protection. As this Court there recognized, "the objective of the Copyright Clause was clearly to facilitate the granting of rights national in scope." *Id.* at 555. Thus, the system of rights and remedies established by Congress pursuant to that Clause is so "pervasive [that] no citizen *or State* may escape its reach." *Id.* at 560 (emphasis added). A cornerstone of this uniform system of copyright and patent rights and remedies is Congress' grant to the federal courts of *exclusive* jurisdiction over copyright and patent cases. 28 U.S.C. § 1338(a). The objective was to keep state courts out of the lawmaking process in these critical spheres. *See, e.g., Sears, Roebuck & Co.* v. *Stiffel & Co.*, 376 U.S. 225, 231 (1964).

Given this Court's recognition of the need for a uniform national system of copyrights and patents, and Congress' grant of exclusive jurisdiction to the federal courts, a ruling in this case that Congress may

not abrogate the states' Eleventh Amendment immunity in Article I legislation would have a substantial negative impact on these *amici*. For the fifty states and their thousands of agencies and instrumentalities are increasingly significant users of intellectual property protected by copyrights and patents. States and their agencies utilize, exhibit, perform and copy these protected works thousands of times every day. In school and college concert halls and football stadiums, on college and public radio stations, and at fraternity social functions, copyrighted music is repeatedly performed, played and danced to; copyrighted motion pictures are exhibited on state college campuses and at state prisons; the latest scientific technology and electronic know-how are utilized by state instrumentalities in great profusion.

As these *amici* have argued in several federal Courts of Appeals, the Copyright Act of 1976 unequivocally expresses Congress' intent that the fifty states either pay copyright royalties or be subject to suit in federal court if they do not. [1] But a ruling from this Court that Congress does not possess the power to abrogate under Article I would open the door wide for state instrumentalities to utilize the creative and scientific work of others — from popular songs to modern symphonies, from the latest movies to lengthy literary manuscripts, from

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[1] These *amici* have submitted *amicus curiae* briefs to the Fourth, Sixth and Ninth Circuits, addressing the issue of congressional abrogation of state immunity under the Copyright Act. *Mihalek Corp.* v. *Michigan*, 814 F.2d 290 (6th Cir.), *cert. denied*, 108 S. Ct. 503 (1987); *BV Engineering* v. *University of California, Los Angeles*, Docket No. 87-5920 (9th Cir.); *Richard Anderson Photography* v. *Radford University*, Docket No. 87-1610 (4th Cir.).

These submissions demonstrated (1) that Congress' intent to abrogate the states' Eleventh Amendment immunity is clear on the face of the Copyright Act and, (2) alternatively, that the state had waived its Eleventh Amendment immunity by its purposeful and affirmative conduct in a sphere regulated exclusively by an act of Congress, under this Court's "consent" doctrine of *Parden* v. *Terminal Ry.*, 377 U.S. 184 (1964). In addition, the Fourth and Ninth Circuit briefs addressed the Article I abrogation issue now before this Court. In *Mihalek*, the Sixth Circuit did not reach the Eleventh Amendment issue. The decisions of the Fourth and Ninth Circuits are still pending.

computer software to patented machinery — all without having to fear suit for failure to pay royalties, as every other user would. Because copyright suits can be brought *only* in federal court, the ultimate effect of such a ruling would be to grant the states a sweeping license to use all copyrighted works "with impunity" — at least until each copyright owner discovers ongoing infringement and can seek whatever limited injunctive relief may be available against future use. [2]

Accordingly, these *amici* join respondent and other *amici curiae* in urging this Court to affirm the holding below that Congress may abrogate states' Eleventh Amendment immunity when acting under Article I of the Constitution. [3]

Summary Of Argument

The purpose of the Eleventh Amendment is to limit judicial action, not to curtail Congress' power. Without the power to abrogate

[2] Several federal courts have considered the question of Eleventh Amendment immunity in copyright and patent cases in recent years, and a split of authority has begun to develop. *Compare, e.g., Mills Music, Inc.* v. *Arizona*, 591 F.2d 1278 (9th Cir. 1979); *Johnson* v. *University of Virginia*, 606 F.Supp. 321 (W.D. Va. 1985); and *Lemelson* v. *Ampex Corp.*, 372 F.Supp. 708 (N.D. Ill. 1974) *with BV Engineering* v. *University of California, Los Angeles*, 657 F.Supp. 1246 (C.D. Cal. 1987); *Richard Anderson Photography* v. *Radford University*, 633 F.Supp. 1154 (W.D. Va. 1986); *Cardinal Industries, Inc.* v. *Anderson Parrish Assocs.*, No. 83-1038, slip op. (M.D. Fla. Sept. 6, 1985), *aff'd without opinion*, 811 F.2d 609 (11th Cir.), *cert. denied*, 108 S. Ct. 88 (1987); *Woelffer* v. *Happy States of America, Inc.*, 626 F.Supp. 499 (N.D. Ill. 1985); and *Mihalek Corp.* v. *Michigan*, 595 F.Supp. 903 (E.D. Mich. 1984), *aff'd on other grounds*, 814 F.2d 290 (6th Cir.), *cert. denied*, 108 S. Ct. 503 (1987). Thus, assuming a decision in this case that Congress may abrogate under its Article I powers, the question whether it *has* done so in the Copyright Act of 1976 may soon be ripe for decision by this Court.

[3] These *amici* have no direct interest in the CERCLA statute at issue in this case — except to the extent that it, too, is an Article I enactment — and they therefore take no position on the first issue presented by petitioner. They also take no position on whether *Hans* v. *Louisiana*, 134 U.S. 1 (1890), should be overruled, as respondent and *amicus* Chemical Manufacturers Association (CMA) urge in their briefs, since it is unnecessary for the Court to overrule *Hans* in order to hold that Congress may abrogate state immunity when acting pursuant to Article I powers. Nonetheless, these *amici* would not oppose the overruling of *Hans*.

under Article I. Congress would remain unable to implement in a consistent and uniform fashion the very legislative responsibilities conferred on it by Article I.

Because the federal courts have exclusive jurisdiction over copyright suits, the effect of a holding by this Court that Congress may not abrogate state immunity under Article I would be to deny copyright owners a damage remedy entirely. That result would frustrate the congressional mandate to create a uniform national system of copyright and patent protection.

This Court's prior decisions strongly suggest that Congress has the power to abrogate state immunity when it acts pursuant to its Article I powers. By fashioning a rule that Congress' intent to abrogate must be clear on the face of its enactments, this Court has implicitly acknowledged that Congress has the authority to abrogate — and may do so when that intention is made explicit.

Argument

CONGRESS MAY ABROGATE THE STATES' ELEVENTH AMENDMENT IMMUNITY WHEN ACTING PURSUANT TO ITS ARTICLE I POWERS

A. There Is No Constitutionally Significant Reason To Exclude Article I Enactments From Congress' Abrogation Power

As respondent and *amicus* CMA persuasively argue in their briefs, there is compelling historical and constitutional support for Congress' power to abrogate state immunity when legislating under Article I. The history of the Eleventh Amendment reveals that its intended purpose was to limit judicial action, not to curtail Congress' power. Integral to the Framers' federal vision is the concept that the states, upon ratifying a Constitution that granted law-making powers to Congress in specific areas, "surrendered a portion of their sovereignty" in those domains. *Parden* v. *Terminal Ry.*, 377 U.S. 184, 191

(1964). Thus, when Congress legislates pursuant to an express grant of authority under Article I, it is also free to make such enactments enforceable against the states by creating private rights of action against the states in federal court. That power is necessary and proper if Congress is effectively to enforce the laws it enacts under its plenary constitutional authority.

Consistent with these principles, every federal appellate court that has expressly decided whether Congress has power to abrogate state immunity under Article I and other plenary powers has held, as did the Third Circuit here, that Congress may abrogate state immunity when it acts pursuant to such powers. *In re McVey Trucking, Inc.*, 812 F.2d 311, 323 (7th Cir.) (Bankruptcy Clause, Art. I, § 8, Cl. 4), *cert. denied*, 108 S. Ct. 227 (1987); *County of Monroe* v. *Florida*, 678 F.2d 1124, 1133 (2d Cir. 1982) (Extradition Power, Art. IV, § 2, Cl. 2), *cert. denied*, 459 U.S. 1104 (1983); *Peel* v. *Florida Dep't of Transportation*, 600 F.2d 1070, 1080 (5th Cir. 1979) (War Powers Clauses, Art. I, § 8, Cl. 11-13); *Mills Music, Inc.* v. *Arizona*, 591 F.2d 1278, 1285 (9th Cir. 1979) (Copyright and Patent Clause, Art. I, § 8, Cl. 8); *Jennings* v. *Illinois Office of Education*, 589 F.2d 935, 937 (7th Cir.) (War Powers Clauses), *cert. denied*, 441 U.S. 967 (1979).

Perhaps the most learned and exhaustive judicial analysis of this issue was that undertaken by Judge Flaum in *In re McVey Trucking, Inc.*, *supra*. The *McVey* opinion began by noting that this Court has made clear that Congress may abrogate state immunity without consent when it acts pursuant to its power under section 5 of the Fourteenth Amendment. 812 F.2d at 314; *see Fitzpatrick* v. *Bitzer*, 427 U.S. 445 (1976). The Seventh Circuit then considered whether there is any constitutionally significant reason to distinguish the grant of power to Congress under the Fourteenth Amendment from those under Article I. After exploring the various theories that have been advanced to draw that distinction, it concluded that there is no viable basis for such a distinction. Article I and the Fourteenth Amendment

are both plenary grants of power to Congress; there is no reason to conclude that "the plenary power of the Fourteenth Amendment grants Congress any more power to bring an unconsenting state into federal court than does the plenary power of Article I." *McVey*, 812 F.2d at 321. Thus, the Seventh Circuit held that Congress is empowered to abrogate by legislating under the Bankruptcy Clause of the Constitution, Article I, § 8, Cl. 4.

As the Seventh Circuit in *McVey* and the Third Circuit here both concluded, there is no sound reason for limiting Congress' abrogation powers to Fourteenth Amendment legislation; its original powers under Article I are at least as critical to the framework of our federal system as its Fourteenth Amendment powers. As Professor Tribe has observed:

> it remains true after the eleventh amendment, . . . that Congress, acting in accordance with its article I powers as augmented by the necessary and proper clause, . . . can effectuate the valid substantive purposes of federal law by . . . compelling states to submit to adjudication in federal courts . . . .

Tribe, *Intergovernmental Immunities in Litigation, Taxation, and Regulation: Separation of Powers Issues in Controversies About Federalism*, 89 Harv. L. Rev. 682, 694 (1976). Indeed, without this power, Congress would remain utterly unable to implement in a consistent and uniform fashion the very legislative responsibilities conferred on it by Article I. Thus, as this Court itself has previously observed, if the Eleventh Amendment were construed to bar private suits seeking to enforce Article I restrictions on state power, these restrictions would become "nullified and made of no effect." *Prout* v. *Starr*, 188 U.S. 537, 543 (1903).

Nowhere would such "nullification" be more effective than in the enforcement of the rights granted by Congress under the Copyright and Patent Clause of Article I. Because Congress has, consistent with

the constitutionally mandated objective of creating a uniform national system of copyright and patent protection, given the federal courts exclusive jurisdiction over copyright suits (as it has also in the realms of bankruptcy, admiralty and antitrust), the result of upholding Eleventh Amendment immunity in copyright suits would be to deny any damage remedy whatever against state infringers. That result would contradict the time-honored common law precept that "[i]f the plaintiff has a right, he must of necessity have means of vindication . . . . Right and remedy . . . are reciprocal." *Ashby* v. *White*, 87 Eng. Rep. 808 (Q.B. 1702). It would leave copyright and patent owners without any means of redress against a significant class of infringers, in contrast to previous Eleventh Amendment decisions of this Court, such as *Employees* v. *Department of Public Health and Welfare*, 411 U.S. 279 (1973), *Edelman* v. *Jordan*, 415 U. S. 651 (1974) and *Welch* v. *State Dep't of Highways and Public Transp.*, 107 S.Ct. 2941 (1987), in which the applicable acts of Congress did not create remedies enforceable *exclusively* in federal court.

Eliminating the prospect of any damage suits at all against the states would be especially harmful to the economic livelihood of those in the music copyright industry represented by these *amici*. It is no secret that much of today's popular music has a very limited life-span. By the time a copyright owner has discovered that a state agency has copied or performed a current song, the chances are high that the song will no longer have any commercial vitality, and an injunction against future use will offer little vindication. In such circumstances, with no damages available, the deterrent effects upon copyright infringers envisioned by Congress would be entirely lost. And that in turn would frustrate the entire notion of a uniform national system of protection as envisioned by the Copyright and Patent Clause. *See Goldstein* v. *California*, 412 U.S. at 555-56. For that reason, a holding by this Court that Congress may not abrogate Eleventh Amendment immunity under any of its Article I powers would deal a devastating blow to

everyone whose livelihood is dependent on copyrights and patents. Accordingly, these *amici* join in urging affirmance of the decision of the Third Circuit on the Article I abrogation issue.

B. This Court's Previous Decisions Suggest That Congress May Abrogate State Immunity Under Its Article I Powers

Although this Court has never expressly held that Congress may abrogate state Eleventh Amendment immunity when it acts pursuant to its authority under Article I of the Constitution, the prior decisions of this Court do not, as petitioner argues, point in the opposite direction. Rather, this Court has strongly and repeatedly suggested that Congress does possess that power.

In *Parden* v. *Terminal Ry.*, *supra*, this Court expressly recognized that Congress possesses the authority under Article I to subject the states to suit in federal court pursuant to its Commerce Clause power. No other conclusion reasonably flows from this Court's declaration in *Parden* that "the States surrendered a portion of their sovereignty when they granted Congress the power to regulate commerce." 377 U.S. at 191. The holding in *Parden* turned on the further determination that the state had impliedly "consented" to suit by operating a railroad in the face of congressional regulation. But this Court clearly first determined — as it must have — that Congress had the power to enact that regulation and bind the states thereby. [4]

Parden was followed by *Employees* v. *Department of Public Health and Welfare*, 411 U.S. 279, 283 (1973), in which this Court reaffirmed Congress' power to make the states amenable to suit in federal court.

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[4] This Court made clear in *Welch* v. *State Dep't of Highways and Public Transp.*, 107 S. Ct. 2941, 2948 (1987), that it was ...ere overruling *Parden only* to the extent that it was "inconsistent with the requirement that an abrogation of Eleventh Amendment immunity by Congress must be expressed in unmistakably clear language . . . ." Nothing in *Welch* disturbs the recognition in *Parden* that Congress has power to abrogate under the Commerce Clause. *See id.* at 2948 n.8.

Implicit in this Court's declaration in *Employees* that immunity will not be lifted absent a clear showing of congressional purpose is the assumption that Congress has authority to lift the veil of immunity when such intent is evident.

In *Atascadero State Hospital* v. *Scanlon*, 473 U.S. 234 (1985), this Court expressly asked whether, if the Rehabilitation Act had been enacted pursuant to Congress' Article I powers, there would be sufficient evidence of congressional intent to overcome Eleventh Amendment immunity. *Id.* at 246–47. Once again, although this Court found no such clear indication, that the question was asked at all demonstrates this Court's belief that Congress may abrogate the states' Eleventh Amendment immunity under its Article I powers.

Six months later, in *Green* v. *Mansour*, 474 U.S. 64 (1985), far from suggesting that the abrogation test was restricted to statutes enacted pursuant to Congress' Fourteenth Amendment powers, as petitioner argues, this Court stated simply that Congress must act "pursuant to a valid exercise of power." *Id.* at 68.

And, most recently, in *Welch* v. *State Dep't of Highways and Public Transp.*, *supra*, this Court assumed, without deciding, that Congress *could* abrogate under its Article I powers. 107 S. Ct. at 2946. Significantly, in *Welch*, this Court expressly declared that it was not questioning the validity of its prior holding in *Parden* that "Congress has the power to abrogate the States' Eleventh Amendment immunity under the Commerce Clause." *Id.* at 2948 n.8.

Fitzpatrick v. *Bitzer*, *supra*, is fully consistent in this regard with the above cases. In holding that Congress has the power to abrogate state immunity pursuant to section 5 of the Fourteenth Amendment, *Fitzpatrick* nowhere cast doubt on Congress' authority to abrogate under any of its Article I powers. On the contrary, *Fitzpatrick* reiterated that the congressional abrogation upheld in *Parden* "was

based on the power of Congress under the Commerce Clause . . . ." 427 U.S. at 452. [5]

Petitioner places primary reliance upon the following statement in *Fitzpatrick*:

> We think that Congress may, in determining what is "appropriate legislation" for the purpose of enforcing the provisions of the Fourteenth Amendment, provide for private suits against States or state officials which are constitutionally impermissible in other contexts. See *Edelman* v. *Jordan*, 415 U.S. 651 (1974); *Ford Motor Co.* v. *Department of Treasury*, 323 U.S. 459 (1945).

Id. at 456 (footnote omitted).

Contrary to petitioner's interpretation, the phrase "constitutionally impermissible in other contexts" cannot be read to question Congress' authority to abrogate state immunity under its Article I powers. The two cases cited directly following that ambiguous phrase clarify what "other contexts" the statement refers to — *i.e.*, contexts in which there has been no act of Congress expressly making the states amenable to suit in federal court. Significantly, neither of the two cases even addressed the issue of Congress' authority to abrogate state immunity under Article I. In *Edelman*, "the threshold fact of congressional authorization to sue a class of defendants which literally includes States [was] wholly absent." 415 U.S. at 672. Since this Court held that Congress had not authorized abrogation, the issue of whether it had the power to abrogate did not arise. The second case, *Ford Motor Co.*, involved a *state* statute, not an act of Congress, and so has nothing at all to do with congressional abrogation. Since neither case addressed Congress' *power* to impose suit upon the states, the quoted statement from *Fitzpatrick* does not cast doubt on Congress' authority to abrogate under any of its powers — Article I or otherwise.

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[5] Moreover, two separate concurrences in *Fitzpatrick* expressly concluded that the congressional abrogation at issue was authorized by the Commerce Clause. 427 U.S. at 458 (Brennan, J., concurring in the judgment); *id.* (Stevens, J., concurring in the judgment).

Conclusion

For the foregoing reasons, these *amici* respectfully ask this Court to affirm the Third Circuit's holding that Congress, when legislating pursuant to power granted by Article I of the Constitution, may abrogate Eleventh Amendment immunity and subject the states to suit in federal court.

Dated: July 11, 1988

Respectfully submitted,

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